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| 09/680,479      | 10/06/2000  | Hidehiro Matsumoto   | Q61026              | 8765             |

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| EXAMINER |
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CHUONG, TRUC T

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| ART UNIT | PAPER NUMBER |
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2179

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,479

Applicant(s)

MATSUMOTO, HIDEHIRO

Examiner

Truc T Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is responsive to Amendment, filed 11/10/04.
2. Claims 1, and 3-32 are pending in this application. Claims 1, 10, 18, 20, 22, and 27 are independent claims, and claims 1, 10, 18, 20, 22, and 27 are amended. This action is made non-final.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 20-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as not being storage medium can be statutory if the “medium” is defined in the specification being tangible. The “medium” as defined on page 13 of the specification as including intangible media such as other kinds of storage medium (therefore including waves, transmission signals, radio signals, etc.). In this case, the applicant has just claimed “other kinds of storage medium”. An appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (U.S. Patent No. 5,870,552) in view of Katz et al. (U.S. Patent No. 6,496,872 B1), and further in view of Haruyama (U.S. Patent No. 5,902,948).

As to claim 1, Dozier teaches a terminal system comprising:

a server (WAN server, col. 3 line 50 and col. 4 line 10) operable to store text content (source document, col. 6 lines 42-52), and Dozier shows help content (suggested anchor items links the target documents from the lists of suggested and potential targets, e.g., col. 14 lines 30-42, col. 14 lines 24-42), wherein the help content includes specific information regarding how to retrieve or use the text content (e.g., col. 14 lines 29-53, and col. 13 line 50-col. 15 line 20); and

although in the System of Dozier, it does not clearly show that the private/personal computer (col. 6 lines 1-28) is a portable terminal, it is well known in the art and would have been obvious to implement the functions/features of the personal computer into a general laptop/portable computer for the user's convenience; and the portable terminal including a text browser (e.g., client computer, col. 6 lines 42-43, figs. 8a-b and 10a-d) operable to access and process the text content stored in said server (e.g., server, col. 3 line 50 and col. 4 line 10, col. 5 line 45 and 6 line 44), and a help browser operable to process the help content stored in said server (e.g., col. 3 lines 50-67);

however, Dozier does not clearly show the help content automatically controls various functions of the portable terminal to enable the user to more easily utilize the text content. Katz clearly teaches desired tasks are automatically performed in response to triggering events, which

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are automatically launched and controlled the GUI applications by only highlighting/displaying some appropriate tasks guiding the user to complete the tasks (e.g., col. 5 lines 7-50, and figs. 2, 3A-B). It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have the automated performing features of Katz in Dozier's template editing system to enable the user to speed up the process by concentrating on the accomplishment of goals, rather than focus upon how to use a computer (col. 2 lines 52-54); but furthermore, the modified system of Dozier in view of Katz still does not show the concept of help content automatically controls various hardware functions of the portable terminal.

Haruyama clearly teaches a performance guide function of designating a key to be depressed by lighting a keyboard LED corresponding to the key, based on automatic performance data on guide tracks, and determining whether the player has correctly operated the designated key (e.g., col. 7 lines 1-20). It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have the LED-on function key of Haruyama in the modified system of Dozier and Katz to ease the system user to improve visualization and time efficiency during navigating/learning process with the computer system.

As to claim 10, it is individual similar in scope to claim 1 above; therefore, rejected under similar rationale.

7. Claims 3-9, 11-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (U.S. Patent No. 5,870,552) and Katz et al. (U.S. Patent No. 6,496,872 B1) in view of Haruyama (U.S. Patent No. 5,902,948), and further in view of Pepe et al. (U.S. Patent No. 5,742,905).

As to claims 8, 9, 16, and 17, the modified Dozier teaches that the portable terminal (see claim 1 above) but does not clearly show the portable terminal can be a cellular phone and a pager, and the PDA set to the effective state, said switch-key controlling means lights up light (or vibrates) emitting sections (or buttons) corresponding to the switch keys being set to the effective state. Pepe clearly teaches a cellular phone, PDA with all functions of a regular PDA (e.g., col. 5 lines 41-67) so the PDA can be set to the effective state, said switch-key controlling means lights up light (or vibrates) emitting sections (or buttons) corresponding to the switch keys being set to the effective state. It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have Pepe's PDA with all features in the modified Dozier's template editing system to provide services to users to communicate from anywhere to anywhere at any time (col. 1 lines 36-39).

As to claims 30-32, they are similar in scope to claim 8 above; therefore, they can be rejected under similar rationale.

As to claims 22 and 27, the modified Dozier teaches a portable terminal communication system comprising:

an information source server connected to a network and operable to separately store target content and help content, wherein the help content is ancillary to the target content and is provided to assist in retrieval of the target content and wherein the help content automatically controls various functions of the portable terminal to enable the user to more easily utilize the text content (see the rejection of claim 1 above and col. 15 line 1-col. 16 line 65); although, Dozier also shows that a standard personal computer is being used to access/connect the Network or the Internet in the invention (e.g., col. 1 lines 12-43) means a user's computer as mentioned

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above could be a Laptop computer, a cellular phone, and PDA (it is well known in the art that those devices could be communicated with others in both wireline and wireless connections). However, the modified Dozier does not specifically show a wireless device, a radio gateway server to connect both wireless and wireline network. Pepe clearly teaches a cellular phone, PDA with using radio signal in communications (e.g., col. 5 lines 41-67, and col. 18 lines 7-28). It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have Pepe's radio signal, wireline, and wireless communications with all features in Dozier's template editing system to provide services to users to communicate from anywhere to anywhere at any time (e.g., col. 1 lines 36-39), and easy to access resources available in different environments.

As to claims 25, 26, 28 and 29, they are similar in scope to claims 8 and 9. Note the rejections of claims 8 and 9 above.

As to claims 3, 11, and 24, the modified Dozier teaches a portable terminal to display text content and help content on a browser (see claim 1 above); however, Dozier does not further teach that the portable terminal further comprises a judging means for judging whether a message inputted from outside belongs to a text message comprising the text content or a help message comprising the help content, and activates either said text browser of said help browser based on a result of judging means. Pepe clearly teaches the judging means for judging whether a message belong to text content or help content (using segment IDs in message delivery and notifications, col. 14 lines 53-67 and col. 15 lines 1-15). It would have been obvious at the time of the invention that a person with ordinary skill in the art would add this highly desirable

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judgment feature of Pepe's communication system in the modified Dozier so that the information can be divided independently and uniquely (e.g., col. 14 lines 54-56).

As to claims 4 and 12, the modified Dozier provides help browser outputs said help content as text, voice, static images, moving images (e.g., col. 1 lines 40-65, col. 13 line 50-col. 14 line 63 and figs. 4, 8a-b).

As to claim 18, it is a method claim that corresponds to the product of claims 10-11. Note the rejections of claims 10-11 above.

As to claim 19, it is a method claim that corresponds to the product of claim 12. Note the rejection of claim 12 above.

As to claim 20, it is a program product claim that corresponds to the product and method claims 10, 11, and 18. Note the rejections of claims 10, 11, and 18 above.

As to claim 21, it is a program product claim that corresponds to the product and method claims 12 and 19 above. Note the rejections of claims 12 and 19 above.

As to claims 5, 6, 7, 13, 14, 15, and 23, the modified Dozier provides a plurality of switch keys for use operations for using said text content, and switch-key controlling means for setting each of said plurality of switch keys to either an effective state or an ineffective state depending on the content of said help content (e.g., using icons, col. 4 lines 11-26).

### ***Response to Arguments***

8. Applicant's arguments filed in an Amendment have been fully considered but they are not persuasive.

Applicants argued and Examiner disagrees for the following reasons:



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- a. There is no motivation or suggestion to combine the “triggering events” disclosed in Katz with the “NaviLinks” system disclosed in Dozier.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Katz clearly teaches desired tasks are automatically performed in response to triggering events, which are automatically launched and controlled the GUI applications by only highlighting/displaying some appropriate tasks guiding the user to complete the tasks (e.g., col. 5 lines 7-50, and figs. 2, 3A-B), and Dozier links the target documents from the lists of suggested and potential targets (e.g., col. 14 lines 30-42); therefore, it would have been obvious to combine the automated performing features of Katz in Dozier's template editing system to enable the user to speed up the process by concentrating on the accomplishment of goals (only perform the suggested and potential targets and appropriate tasks), rather than focus upon how to use a computer (col. 2 lines 52-54).

- b. There is no motivation or suggestion to combine “Dozier”, “Katz”, and “Pepe”.

Dozier clearly shows the judgment by automatically generating a list of suggestions (help content) and then review the suggestions based on the provided information (text content) (col. 13 line 50-col. 15 line 20), processing an appropriate

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message to the application server, causing server software to initiate appropriate database actions (col. 15 line 1-col. 16 line 65) such as incorporating, modifying, or discarding the input information (col. 13 lines 60-67) by defining and comparing the input information (the provided information) with the suggested anchor items (the list of suggestions) (col. 13 line 50-col. 14 line 62); Katz clearly teaches desired tasks are automatically performed in response to triggering events, which are automatically launched and controlled the GUI applications by only highlighting/displaying some appropriate tasks guiding the user to complete the tasks (see (a)); and the system of Pepe is based on the user profiles (IDs) to deliver/distribute/forward messages and notifications to the user (only suggested/potential targets or appropriate tasks will be considered during the processes of the system of Pepe) (e.g., col. 14 lines 53-67 and col. 15 lines 1-15).

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

04/16/05

  
BA HUYNH  
PRIMARY EXAMINER